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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,171	02/11/2004	John V. Bernardi	71-839-1	1006
<div>7590 Steven W. Weinrieb SCHWARTZ & WEINRIEB Crystal Plaza One, Suite 1109 2001 Jefferson Davis Highway Arlington, VA 22202</div>			<div>EXAMINER NGUYEN, CHI Q</div>	
			<div>ART UNIT 3635</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 06/19/2007</div>	<div>DELIVERY MODE PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/775,171

Applicant(s)

BERNARDI ET AL.

Examiner

Chi Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-12 and 14-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-12 and 14-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/11/04 and 11/27/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the applicant's continuing patent application filed on 2/11/2004.

Claim Objections

Claim 7 is objected to because of the following informalities: in line 15, a citation "said pro-jections" should read --said projections--. In line 18, a citation "decking substruc-ture" should read --decking substructure--. Claim 8, line 15, a citation "the environ-mental" should read --the environmental--. Claim 19, line 16, a citation "said pro-jections" should read --said projections--, and in line 19, a citation "decking substruc-ture" should read --decking substructure--. Claims 18-19, line 16, a citation "said project-tions" should read --said projections-- Appropriate correction is required.

Claim Rejections - 35 USC §.103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-30, 2-12, 31-36, and 14-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,382,353 to Kelly in view of US Patent No. 4,787,188 to Murphy.

Claims 25, 27:

Kelly discloses an assembly of reverse furring technique comprising: a substrate 11, comprising at least one ply, having a longitudinal extent and predetermined first transverse dimension as defined between oppositely disposed side edge portions; and a plurality of fastener 21, for fixing environmental membranes upon an underlying an underlying roof decking substructure, having second transverse dimensions which are not greater than said first transverse dimensions of said substrate so as to be fixedly mounted upon said at least one ply of said substrate in such a manner that said plurality of fastener are disposed transversely inwardly between said oppositely disposed side edge portions of said substrate, and at predeterminedly spaced positions spaced along said longitudinal extent of said substrate, so as to define with said substrate an integral product entity such that when a first one of said plurality of fastener is fixedly secured at a first location along the underlying roof decking substructure by means of said fastener, the remaining ones of said plurality of fastener, fixedly attached to said substrate at said predetermined positions spaced along said longitudinal extend of said substrate.

Kelly discloses the basic structures for an assembly of reverse furring technique as stated above but does not expressly disclose the assembly comprises a plurality seam plates are to be fixedly secured by the fasteners so as to ensure the proper fixation of said seam plates to the underlying roof decking substructure whereby, in turn, the fixation of the environmental membranes upon the underlying roof decking substructure, will likewise be ensured. Murphy discloses stress plate or seam plate for securing a roof membrane to a roof deck comprising a plurality of 10 and each of the seam plate 11 having opening 15 for receiving an appropriate fastening means such as

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screws (see Fig. 1, col. 2, lines 1-2). At the time of the invention was made, it would have been obvious to a person having an ordinary skill in the art to combine Kelly with Murphy for a plurality of seam plates for securely attached roofing membranes more securement and preventing back-out fasteners that normally caused by strong wind,

Claim 26:

Wherein said substrate comprises a structure selected from the group comprising a suitable metal sheet strip (col. 2, line 24).

Claims 28, 5, 9-11:

Wherein said substrate comprises a flattened tubular member and said plurality of seam plates are fixedly secured within said tubular member by means of adhesive material (see col. 2, line 49. Note that the limitation of "heat-sealed" would have been considered method of forming a device and is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Claims 29-30:

Kelly in view of Murphy disclose the basic structures for the roofing structures as stated but do not disclose expressly wherein said substrate is fabricated from a suitable material which exhibits a sufficient amount of flexibility so as to permit said substrate to be rolled into a coiled form and wherein said substrate is fabricated from a suitable material which exhibits a sufficient amount of flexibility so as to permit said substrate to be folded in a pleated array in order to permit said seam plates to be stacked in a nested array with respect to each other. A term "fabricated" would have been

considered method of forming a device and is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Claims 2-3:

Kelly discloses the basic structures for a roofing assembly and further wherein when the underlying roof decking substructure comprises a corrugated 3 or non-corrugated 1 roof decking substructure, comprising a plurality of crest portions 5 spaced from each other by means of predetermined distances but does not disclose a plurality of seam plates are fixedly mounted upon said substrate at predeterminedly spaced positions which correspond to the predetermined distances defined between the plurality of spaced crest portions of the underlying corrugated roof decking substructure so as to ensure said plurality of seam plates can be fixedly secured to the plurality of spaced crest portions of the underlying corrugated roof decking substructure. Murphy discloses stress plate or seam plate for securing a roof membrane to a roof deck comprising a plurality of 10 and each of the seam plate 11 having opening 15 for receiving an appropriate fastening means such as screws (see Fig. 1, col. 2, lines 1-2). At the time of the invention was made, it would have been obvious to a person having an ordinary skill in the art to combine Kelly with Murphy for a plurality of seam plates for securely attached roofing membranes more securement and preventing back-out fasteners that normally caused by strong wind, etc.

Claims 4, 6-8, 12:

Kelly discloses the basic structures for a roofing assembly as stated but does not disclose expressly wherein each one of said plurality of seam plates has a plurality of

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projections extending downwardly from undersurface portions of each one of said plurality of seam plates for engaging each one of the environmental membranes and said substrate has a substantially C-shaped cross-sectional configuration comprising an upper planar member disposed atop said plurality of seam plates and a pair of lower planar flap-type members folded inwardly from opposite side edge portions of said upper planar member. Murphy discloses stress plate or seam plate for securing a roof membrane to a roof deck comprising a plurality of 10 and each of the seam plate 11 having a plurality of projections or prongs 21 (see Fig. 3, col. 2, line 7) extending downwardly from undersurface portion of each one of said plurality of seam plate (see Figs. 1-2) and opening 15 for receiving an appropriate fastening means such as screws (see Fig. 1, col. 2, lines 1-2). At the time of the invention was made, it would have been obvious to a person having an ordinary skill in the art to combine Kelly with Murphy for a plurality of seam plates for securely attached roofing membranes more securement and preventing back-out fasteners that normally caused by strong wind, etc. Kelly in view of Murphy disclose the basic structures for a roofing assembly as stated but do not disclose the substrate has a substantially C-shape cross sectional configuration. However, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made to have such a C-shaped cross sectional substrate for desirable application. Furthermore, applicant has not disclosed the criticality of this feature.

Claim 31:

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Kelly discloses an assembly of reverse furring technique comprising: an underlying roof decking substructure 3, an insulation panel 7 disposed atop said roof decking substructure, a plurality of environmental membranes 19 adapted to be fixedly secured atop said insulation panel 7, at least one substrate 11, comprising at least one ply, having a longitudinal extent and predetermined first transverse dimension as defined between oppositely disposed side edge portions; and a plurality of fastener 21, for fixing environmental membranes upon an underlying an underlying roof decking substructure, having second transverse dimensions which are not greater than said first transverse dimensions of said substrate so as to be fixedly mounted upon said at least one ply of said substrate in such a manner that said plurality of fastener are disposed transversely inwardly between said oppositely disposed side edge portions of said substrate, and at predeterminedly spaced positions spaced along said longitudinal extent of said substrate, so as to define with said substrate an integral product entity such that when a first one of said plurality of fastener is fixedly secured at a first location along the underlying roof decking substructure by means of said fastener, the remaining ones of said plurality of fastener, fixedly attached to said substrate at said predetermined positions spaced along said longitudinal extend of said substrate.

Kelly discloses the basic structures for an assembly of reverse furring technique as stated above but does not expressly disclose the assembly comprises a plurality seam plates are to be fixedly secured by the fasteners so as to ensure the proper fixation of said seam plates to the underlying roof decking substructure whereby, in turn, the fixation of the environmental membranes upon the underlying roof decking

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substructure, will likewise be ensured. Murphy discloses stress plate or seam plate for securing a roof membrane to a roof deck comprising a plurality of 10 and each of the seam plate 11 having opening 15 for receiving an appropriate fastening means such as screws (see Fig. 1, col. 2, lines 1-2). At the time of the invention was made, it would have been obvious to a person having an ordinary skill in the art to combine Kelly with Murphy for a plurality of seam plates for securely attached roofing membranes more securement and preventing back-out fasteners that normally caused by strong wind,

Claim 32: See rejections of claim 26 above.

Claim 33:

Wherein said substrate 11 comprises at least a pair of substrates fixedly connected together along at least one longitudinally extending seam portion (see Fig. 1).

Claims 34, 17, 2-23: See rejections of claims 28, 5, and 9-11 above.

Claims 35-36: See rejections of claims 29-30 above.

Claims 14-15: See rejections of claims 2-3 above.

Claims 16, 18-20, and 24: See rejections of claims 4, 6-8, and 12 above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (571) 272-6847. The examiner can normally be reached on Monday-Friday from 7:30 am-4:00 pm.

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If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at (571) 272-6777.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at (866) 217-9197.

CQN

6/1/2007

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